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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,935

06/29/2005

Toshiyuki Ohara

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08/07/2006

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EXAMINER

MORROW, JASON S

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/540,935

Applicant(s)

OHARA, TOSHIYUKI

Examiner

Jason S. Morrow

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 6 and 11 refer to a device that is configured to horizontally move and store the first article, however, such a mechanism is not described in any way in the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2, 3, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Starling (US Patent 3,480,293).

Re claim 2, Starling discloses a device for storing an article for protecting an automobile body, said device comprising a first article (30, the device is capable of protecting the bumper 11 in a limited area), which is configured to protect the automobile body; and a second article (20),

which surrounds an axis of rotation (51) positioned within the automobile body, wherein said first article and said second article are attached to form a rotatable body, which rotates about said axis of rotation, said rotatable body having a first position (shown in figure 2) and a second position (shown in figure 3) such that, in said first position, said first article extends from the automobile body to protect the automobile body, and, in said second position, said first article is concealed within the automobile body, and wherein the rotating body must rotate 180 degrees to change its position from said first position to said second position.

Re claim 3, said second article is formed of the same material as the automobile body (the cross-hatching shown in figure 3 indicates they are of the same material).

Re claim 7, Starling discloses a device for storing an article for protecting an automobile body, said device comprising a first article (30), which is configured to protect the automobile body; and a second article (20), which surrounds an axis of rotation (51) positioned within the automobile body, wherein said first article and said second article are attached to form a rotatable body, which rotates about said axis of rotation, said rotatable body having a first position (shown in figure 2) and a second position (shown in figure 3) such that, in said first position, said first article extends from the automobile body to protect the automobile body, and, in said second position, said first article is concealed within the automobile body, and wherein, with respect to a cross-section taken perpendicular to said axis of rotation, said axis of rotation extends along the center (along the line 4-4 in figure 2) of said second article (as shown in figure 2).

Re claim 8, said second article is formed of the same material as the automobile body (the cross-hatching shown in figure 3 indicates they are of the same material).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starling (US Patent 3,480,293).

Starling discloses all of the limitations of the claims, as applied above, except for a switch, either remote or inside the vehicle, which is operative to activate electric power to rotate the rotating body between the first position and the second position.

The examiner takes Official Notice that remote switches, switches inside vehicles, and electric motors for rotating objects are old and well known in the art. Note that since applicant has not challenged the taking of Official Notice in response to the previous Office Action, the limitations are now taken as admitted prior art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a device, such as that disclosed by Starling, to have a switch, either remote or inside the vehicle, which is operative to activate electric power to rotate the rotating body between the first position and the second position, as is old and well known in the art, in order to provide an added convenience and luxury for the user of the automobile.

Response to Arguments

7. Applicant's arguments with respect to claims 2-5 and 7-10 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 5/24/06 with regard to claims 6 and 11 have been fully considered but they are not persuasive.

Applicant argues that prior art references disclose mechanisms for horizontally moving a first article and that one of ordinary skill in the art would be able, in light of the prior art, to make the claimed invention. The examiner respectfully disagrees. The prior art is all directed to mechanisms for horizontally and moving an article. None of them disclose how such a device would operate in combination with the article being rotatable 180 degrees. This is exactly the feature which applicant rests a large degree of the patentability of the claims on. Having a device not only be horizontally movable, but also including a 180 degree rotating feature would require a significant amount of structure not disclosed by Applicant. It would require undue experimentation for one of ordinary skill in the art to construct the invention as claimed in claims 6 and 11.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason S. Morrow whose telephone number is (571) 272-6663. The examiner can normally be reached on Monday-Friday, 8:00a.m.-4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on (571) 272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason S. Morrow
Primary Examiner
Art Unit 3612

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July 31, 2006


JASON MORROW
PRIMARY PATENT EXAMINER
7/31/06